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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/728,056 | 12/04/2000 | Pascal Arnaud | 200436US0 | 3932 |

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OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER

WILLIS, MICHAEL A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 10/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,056

Applicant(s)

ARNAUD, PASCAL

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's amendment and IDS of 24 July 2002 are entered. See attached initialed and signed copy of PTO-1449. Claims 5 and 6 are amended. Claims 1-44 are pending. The claims are examined as they read on the elected species of isododecane, phenyltrimethicone, and diglyceryl diisostearate. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claims 1-44 are rejected under 35 USC 103(a) as being unpatentable over Walling et al (US Pat. 5,948,394) in view of Jakobson et al (US Pat. 5,093,043) for reasons as stated previously.

Applicant argues by attacking the references individually. Applicant argues that since Walling does not disclose diglyceryl diisostearate, therefore Walling does not appreciate the benefits of the claimed composition. Applicant further argues that Walling's disclosure of isododecane and phenyltrimethicone constitute a laundry list of ingredients, and therefore does not render obvious the instant invention, especially since the six examples disclosed by Walling use DC 244 or DC 345 rather than DC 556. Additionally, applicant argues that Jakobson fails to compensate by asserting that Jakobson's preference for diglyceryl diisostearate is specific for the disclosed process, and not a general teaching that diglyceryl diisostearate is better than polyglyceryl diisostearate. Also, applicant argues that Jakobson fails to suggest that diglyceryl

diisostearate maintains its improved properties when combined in a composition according to the instant invention. Finally, applicant argues that a direct comparison of a composition according to the instant invention is superior to Revlon "liquid lip".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The fact that Walling does not disclose or appreciate the benefits of diglyceryl diisostearate is moot, when the substitution of diglyceryl diisostearate for polyglyceryl diisostearate is motivated by the teachings of Jakobson. Applicant's arguments regarding "laundry-list" of ingredients of Walling is not convincing where Walling teaches that a preferred hydrocarbon fluid for use in the invention is isododecane (see col. 4, lines 1-16; and col. 6, line 15 through col. 7, line 45; examples 1-6), and further that phenyltrimethicone is a most preferred fluid for the invention (see col. 5, lines 17-20).

In response to applicant's argument that Jakobson's teachings are specific for the process and not a general teaching, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Even if, *arguendo*, Jakobson's teachings relate to diglyceryl diisostearate produced in the manner taught, such diglyceryl

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diisostearate still satisfies the limitation of "diglyceryl diisostearate" as claimed. In response to Applicant's assertion that one would not want to combine the improved diglyceryl diisostearate of Jakobson with other ingredients so as to preserve the improved properties, Jakobson clearly teaches that diglyceryl diisostearate is used with a wide variety of other ingredients for the skin (see col. 7, line 20 through col. 8, line 28; and abstract).

With respect to the direct comparison of Example 4 with a Comparative Example (Revlon "liquid lip") in the specification, the comparison is not relevant in that it lacks a comparison of the elected species with the closest prior art. Rather, the comparison is between Example 4, which does not even contain the elected species of diglyceryl diisostearate, with a composition "not containing the combination according to the invention". Therefore, such results are not convincing.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30pm).

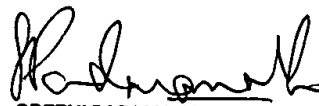
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

maw
October 16, 2002



SREENI PADMANABHAN
PRIMARY EXAMINER

10/16/02